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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,848	09/25/2001	Ronald G. French	509152000500	9332

20350 7590 11/30/2004

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,848

Applicant(s)

FRENCH ET AL.

Examiner

Urmi Chattopadhyay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 24, 26-33, 36, 42-44, 46, 47, 50-86 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 35 and 39 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 12-23, 25, 34, 37, 38, 40, 41, 45, 48, 49 and 87-89 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 9/16/04 has been entered. The changes to the claims have been approved by the examiner. Claims 1-90 are pending; claims 24, 26-33, 36, 42-44, 46, 47, 50-86 and 90 remain withdrawn from consideration; claims 1-23, 25, 34, 35, 37-41, 45, 48, 49 and 87-89 are being considered for further examination on the merits.

Terminal Disclaimer

2. The Terminal Disclaimer filed 9/16/04 is disapproved because it is not proper. The application/patent being disclaimed has been improperly identified since the number used to identify the patent being disclaimed is incorrect. The correct number is 6,695,769 (not 6,695,760).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-8, 11, 35 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30, 34 and 36-39 of U.S. Patent No. **6,695,769**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above listed patent claims include all the limitations of the listed application claims, and the claimed invention of the application is broader in scope than that of the patent. Both application and patent claim an enclosure generally conforming in shape to at least a portion of the heart (epicardium) and including a compliant and substantially non-elastic (flexible) member having an interior surface tending to inhibit adhesions with the epicardium and an exterior surface (webbing) for attachment to the interior of the pericardium. The member comprises more than one adjacent layers of material contiguous across the interior and exterior surfaces (non-adherent material is laminated to at least one other layer in the flexible member).

Allowable Subject Matter

5. Claims 9, 10, 12-23, 25, 34, 37, 38, 40, 41, 45, 48, 49 and 87-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Upon allowance of generic claim 1, withdrawn claims 24, 26-33, 36, 42-44, 46, 47, 50-86 and 90 will no longer be withdrawn from consideration. They will be allowable only if they cannot be objected to or rejected. Applicant should review each of these withdrawn claims and make any necessary corrections in response to this office action to expedite prosecution. The following are objections and rejections that would be given by the examiner in the next office action:

- a) Claim 50 is objected to. On line 3, --is-- should be inserted before "configured".
- b) Claims 58 and each of claims 75-80 are rejected under 112, second paragraph. There is no antecedent basis for "the webbing" in the claim.
- c) Claim 73 is rejected under 112, second paragraph. There is no antecedent basis for "the multiple zigzag ribs" in the claim. It appears that the claim should be dependent on claim 72 rather than on claim 66.

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d) Claims 77 and 78 are rejected under 112, second paragraph. The claims are not commensurate in scope with claim 55, on which they depend. Claim 55 requires "at least one rib" and claims 77 and 78 require "at least some of the multiple ribs". It must first be established that there is more than one rib.

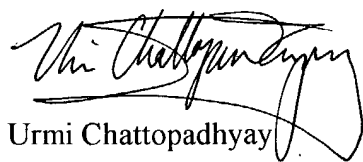
e) Claim 81 is rejected under 112, second paragraph. There is no antecedent basis for "the upper end" and "the apical end" in the claim.


f) Claim 82 is rejected under 112, second paragraph. There is no antecedent basis for "the looping deployment tool" in the claim. It appears that the claim should be dependent on claim 81 rather than on claim 55.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urmi Chattopadhyay whose telephone number is (571) 272-4748. The examiner can normally be reached on Tuesday-Thursday 10:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Urmi Chattopadhyay


David J. Isabella
Primary Examiner